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JFW**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Schneider et al.

Examiner: N. EBRAHIM

Serial No.: 10/630,375

Art Unit: 1618

Filing Date: July 29, 2003

For: RECONSTITUTABLE FORMULATION AND AQUEOUS SUSPENSION OF GAS-FILLED MICROVESICLES FOR DIAGNOSTIC IMAGING

Certificate of Mailing and/or Transmission Under 37 C.F.R. § 1.8(a)(1)(i)(A)(ii)

I hereby certify that the following correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or being facsimile transmitted to the USPTO (571) 273-8300, on the date indicated below:

1. Petition Under 37 CFR 1.137(b): 3pp
2. Exhibits "A" – "C": 5pp; and
3. Claim amendment in compliance with 37 CFR 1.121: 11pp

Date: July 16, 2007Signature: Pamela Gewirtz

Pamela Gewirtz

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.137(b) FOR**UNINTENTIONAL ABANDONMENT OF UTILITY APPLICATION**

Sir:

Practitioner believes the immediate nonprovisional application to be abandoned, although no *Notice of Abandonment* has yet issued. Practitioner bases this belief on the following history for the immediate application:

- 1) a restriction requirement issued October 13, 2006;
- 2) Practitioner filed a responsive reply to the Office action on November 13, 2006;
- 3) In response to the submission, a *Notice of Non-Compliant Amendment* (37 CFR 1.121) issued on December 4, 2006;
 - a. Since the submitted amendment was neither an after-final amendment or an amendment filed after allowance, the *Notice* gave a one month time period to respond, with extensions of time available under 37 CFR 1.136(a);
- 4) Practitioner received the Notice on December 22, 2006 (Exhibit "A": copy of December 4, 2006 Notice, with the stamped "received by" date);
- 5) Practitioner filed a response to the *Notice* on January 4, 2007. The response was filed within the statutory time allotted for response to the *Notice of Non-Compliant Amendment* (37 CFR

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1.121), that is, by January 4, 2007. (Exhibit "B": copy of the USPTO's *auto-reply facsimile transmission* showing confirmation of receipt on January 4, 2007);

- 6) In response to Practitioner's submission to the *Notice of Non-Compliant Amendment (37 CFR 1.121)*, a *Failure to acceptably Respond to Notice of Non-Compliant Amendment, No New Time Period for Reply is Provided* issued on July 9, 2007.

Practitioner wishes to revive the instant unintentionally abandoned application and states that the entire delay in filing the compliant reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.136(b) was unintentional. Furthermore, Practitioner wishes to explain the circumstances surrounding the unintentional abandonment. The December 14, 2006 Notice of Non-Compliant Amendment (37CFR 1.121) read "new claims should not be underlined". Practitioner acknowledges the error made with regards to the underlining of new claims, and dutifully submitted the set of new claims showing no underlining. Additionally, the *Notice*, under "Time Periods For Filing A Reply To This Notice, number (2) read "...the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121. (Exhibit "A").

Practitioner interpreted the instruction to read that only the section of the amendment which was non-compliant with 37 CFR 1.121, i.e. the underlining of new claims, was to be corrected. Thus Practitioner's response to the *Notice*, which was filed on January 4, 2007, listed only that section for which correction was required: the new claims. Practitioner identified the amendments as "the listing of new claims will replace the prior version and listing of *New* claims as filed on November 13, 2006 in the application.

Practitioner spoke with the Examiner appointed for the immediate application on May 21, 2007. Examiner Ebrahim relayed that she was unaware of Practitioner's response to Notice of Non-Compliant amendment because it did not get placed on her active docket. Examiner Ebrahim was kind enough to relay that she would follow up with this matter within the USPTO. Practitioner's paralegal did not receive any news as to the Notice and followed up with Examiner Ebrahim. The same response was given to Practitioner's paralegal. Shortly thereafter, the July 9, 2007 Notice, Failure to Acceptably Respond to Notice of Non-Compliant Amendment No New Time Period for Reply is Provided (Exhibit "C") issued. The July 9, 2007 Notice clarified that which was lacking in Practitioner's January 4, 2007 response. The *Notice* emphasized "only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted". With regards to a time period for response, the *Notice* read that the period for reply continues to run from the mailing date of the prior Notice of Non-Compliant Amendment. The mail date of the prior Notice was December 4, 2006. The time period to reply ended June 4, 2007. Thus the immediate application is abandoned.

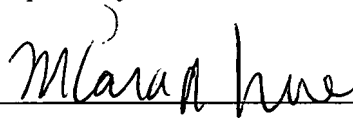
Practitioner had shown good faith and due diligence in attempting to correctly respond to both the Office action and initial Notice. It was believed the submission to the Office action was "fully responsive". Upon receiving the December 4, 2006 Notice, Practitioner responded promptly, and with the belief the submission was "fully responsive". Practitioner has shown the efforts to move the prosecution of the immediate application forward by duly responding to all Office action and Notices within the allotted time. Although no *Notice of Abandonment* has yet issued, Practitioner wishes to move the prosecution forward and to request revival of the immediate application, which is effectively, although unintentionally, abandoned.

In compliance with 37 CFR 1.137(b), Practitioner sets forth the following criteria required to meet the requirements of a grantable petition:

- 1) the reply required to the outstanding Notice in compliance with 37 CFR 1.121(c)(3) is attached;
- 2) the petition fee as set forth in 37 CFR 1.17(m) in the amount of: \$1,1500.00 can be charged to Deposit account 50-2168;
- 3) Practitioner's statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional is indicated in the petition; and
- 4) Since this utility application was filed on or after June 8, 1995, no terminal disclaimer is required.

It is reiterated that Director is hereby authorized to charge all required fees and credit any overpayments to Deposit Account No. 50-2168.

Respectfully submitted,



Dated: July 16, 2007

M. Caragh Noone, Reg. No. 37,197

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**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

JUL 19 2007

Application No.

10/630,375

Examiner

EBRAHIM

Applicant(s)

SCHNEIDER ET AL.

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on ~~19 November 2006~~ is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: New claims should not be underlined.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

BRENDA MURPHY

Legal Instruments Examiner (LIE), if applicable

571 272-1033

Telephone No.